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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184197
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**UNITED PARCEL SERVICE,
OF AMERICA, INC.**

Opposer,

v.

**POWERTECH INDUSTRIAL
CO. LTD.**

Applicant.

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Opposition No. 91184197

Ser. No. 77/176,134

Mark: HYBRID GREEN UPS

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OPPOSER UNITED PARCEL SERVICE OF AMERICA, INC.'S REPLY BRIEF

I. Introduction

The designation “HYBRID GREEN UPS” is merely descriptive. The Applicant Powertech Industrial Co. Ltd. (“Applicant” or PICL) disclaimed the letters UPS as descriptive of an uninterruptible power system. The remaining words describe features of Applicant’s uninterruptible power system. The word “hybrid,” which refers to a combination of two or more different things, describes the feature of Applicant’s uninterruptible power system that simultaneously provides AC and DC power. The word “green,” which refers to environmentally sensitive products, describes the ability of Applicant’s uninterruptible power system to reduce waste in the delivery of that power. PICL’s own use of these terms in a descriptive manner on its website and in its patent application confirm that “HYBRID GREEN UPS” is merely descriptive within the meaning of 15 U.S.C. §1052(e)(1).

Use of the designation “HYBRID GREEN UPS” is likely to cause confusion. Applicant PICL intends to use “HYBRID GREEN UPS” in connection with electronic goods and power supplies, generally, in Class 9. Such use is likely to cause confusion with Opposer United Parcel Service of America, Inc.’s (“Opposer” or UPS) use of the famous mark “UPS”. UPS uses the famous mark “UPS”, and a family of other marks which include the famous mark “UPS”, in connection with numerous goods and services, including electronic goods, power supplies, computer hardware and software. UPS is the owner of registrations for such “UPS” marks, including for electronic goods, power supplies, computer hardware and software in Class 9. Applicant admits that the mark

“UPS” is famous. Fame plays a dominate role in the likelihood of confusion analysis. PICL’s arguments notwithstanding, fame is not limited to the specific products and services on which the mark is used. To the contrary, fame rightly extends to related goods and even to goods that are not closely related. Recot, Inc. v. Becton, 214 F.3d 1322, 1327 (Fed. Civ. 2000). Applicant pays lip service to this established law, but fails to account for the dominant effect of fame in its du Pont analysis. An appropriate du Pont analysis demonstrates that use of the designation “HYBRID GREEN UPS” is likely to cause confusion within the meaning of 15 U.S.C. §1052(d).

II. Applicant’s Own Actions Confirm That “HYBRID GREEN UPS” Is Merely Descriptive

A trademark is merely descriptive under §2(e)(1) of the Trademark Act if the mark describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. TMEP § 1209.01(b), 15 U.S.C. §1052(e)(1). Whether or not a mark is merely descriptive requires consideration of the context in which the mark is used or is intended to be used in connection with the goods or services. Id. The mark does not need to describe all of the goods identified in the application, so long as it describes one of them. Id.

Merriam-Webster’s Online Dictionary defines “hybrid” as “something (as a power plant, vehicle, or electronic circuit) that has two different types of components performing essentially the same function. “hybrid.” Merriam-Webster Online Dictionary. 2010. Merriam-Webster Online. 27 May 2010 <http://www.merriam-webster.com/dictionary/hybrid>. Thus, for example, a hybrid circuit would include different types of components, such as a stereo amplifier that uses both tubes and transistors. *See*, Computer Dictionary, Microsoft Press, Second Edition, “hybrid circuit.”

Of course, as explained in Opposer's Main Brief, the term "green" is indicative of environmentally friendly processes and products. Main Brief of Opposer, pp. 28 - 30.

Here, the "hybrid" uninterruptible power supply is one that provides two different types of power: AC (alternating current) and DC (direct current). The PICL website, under the term "hybrid," states: "Hybrid. Coexist Power system Provide AC and Multi-Range DC Output simultaneously." *See*, www.power-tech.com.tw/product-e2-11.html. Regarding the term "green," the PICL website, states: "Green. Energy Saving & Material Resources Economically." *Id.* The PICL patent application puts the two concepts together in the context of an uninterruptible power system as follows:

Consequently, the hybrid green uninterruptible power system concurrently having an AC power output port and a DC power output port according to the present invention can meet different demands and significantly improve the efficiency of energy conversion between the UPS battery and the external device, thereby less energy is wasted during converting power.

As discussed below, Applicant is not using "hybrid green uninterruptible power system", the equivalent of "hybrid green UPS", as a trademark. Rather, PICL is using those terms descriptively to refer to an uninterruptible power system that can provide AC and DC power simultaneously in an environmentally friendly manner that does not waste energy.

a. Applicant's Reliance on Prior Registrations Is Misguided

Applicant relies on prior registrations in Class 9 that contain either "Hybrid" or "Green" with no disclaimer to support its assertion that "HYBRID" and "GREEN" are not merely descriptive. This reliance is misguided for several reasons. First, third party registrations are not evidence of use in commerce. Second, as to any registrations now cited, such registrations were neither pleaded nor cited in any discovery or notice of reliance. Opposer respectfully submits that they should not be considered. Third, and most

importantly, prior registrations are not conclusive on the question of descriptiveness. TMEP § 1209.03(a). Each application or case must and does stand on its own merits, within the context of the intended use to be made of the subject mark, including any use that has been made by the applicant. Here, PICL's own use is highly probative and establishes that "HYBRID GREEN UPS" is merely descriptive. A mark that is merely descriptive should not be registered on the Principal Register simply because other marks that may be used in varied and oftentimes different contexts appear on the register using a same term. Id.

Even then, several of the registrations relied on by Applicant were, in fact, found to be descriptive by the Trademark Office. For example, Registration No. 3,083,913 for CLEAN GREEN POWER MACHINE is registered on the Supplemental Register, and thus, the Registrant has admitted that the mark is descriptive. Additionally, Registration No. 3,571,724 for the mark DIGITAL HYBRID WIRELESS was only allowed registration on the Principal Register with a showing of acquired distinctiveness under § 2(f) of the Trademark Act. Neither the presence nor absence of third party registrations is probative here, and certainly not sufficient to overcome PICL's own descriptive use on its website and in its patent application.

b. Applicant's Own Use of Applicant's Mark Proves Descriptiveness

PICL argues that its use of "hybrid green ups" to describe its uninterruptible power supply in the specification of Patent Pub. No. 2008/0238205 does not imply that mark is merely descriptive. Applicant's Main Brief, pp. 33-34. However, the function of the specification of a patent is to describe the invention claimed in "full, clear, concise and exact terms." 35 U.S.C.S. §112. PICL does precisely that.

PICL has admitted for its own purposes that the designation UPS is descriptive of an uninterruptible power system. The first sentence of the PICL patent application describes the invention in clear and concise terms: “The present invention is related to an uninterruptible power system (UPS), and more particularly, to a hybrid green uninterruptible power system which concurrently has an AC output port and a DC output port, a bi-directional converter module and a power conversion method thereof.” Opposer Supplemental Notice of Reliance, Ex. 2, Col 1, para. 0002. Thus, from the start, PICL has publicly described its alleged invention as a hybrid that provides AC and DC power ports. Under the summary of the invention section, Applicant states that “the object of the present invention is to provide a hybrid green uninterruptible power system, a bi-directional converter, and a power conversion method thereof...[whereby] the hybrid green uninterruptible power system induces the additional DC power regardless of whether the AC utility power is normal or invalid.” Id. at para. 0011. Thus, in the objects section of the application, PICL has informed the public that its invention is a hybrid uninterruptible power system that induces DC power in addition to the delivery of AC power. With reference to environmental concerns, PICL decries the loss (waste) of 40% or 50% of power in prior art devices (see Col. 2, para. 0008), and touts the loss of only 20% of power as one of the environmental benefits provided by PICL’s alleged invention. See Supplemental Notice of Reliance, Ex. 2, Col 1, para. 0044. PICL repeatedly and descriptively refers to the invention throughout the patent application as “a hybrid green uninterruptible power system.” In fact, at no time does the application make a trademark use of the term. Id.

In its main brief, Applicant fails to address its descriptive use of “hybrid” and “green” on its website where it advertises its uninterruptible power systems. Each term is featured above the definition of the term. “Hybrid” describes “coexist power system provide AC & multi-range DC output simultaneously.” “Green” describes “energy saving & material resources economically.” Opposer’s Supplemental Notice of Reliance, Ex. 3. Thus, there is no dispute that PICL has made a descriptive use of the terms in its website. With reference to the patent application, Applicant simply asserts that its use is a trademark use. As shown above, this is simply not the case.

Applicant disclaimed the designation UPS.¹ It is clear from Applicant’s own use that the terms “hybrid” and “green” are descriptive of a characteristic or quality of at least the uninterruptible power supplies and uninterruptible power systems identified in the application. As such, “HYBRID GREEN UPS” is merely descriptive within the meaning of 15 U.S.C. §1052(e)(1) and should be denied registration.

III. A Likelihood of Confusion Exists

The factors set forth in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) weigh in favor of a likelihood of confusion. The designation “HYBRID GREEN UPS” is very similar to the famous mark “UPS.” In fact, the designation wholly incorporates the famous “UPS” mark. Applicant touts its disclaim of “UPS” as merely descriptive.² However, Applicant’s disclaimer of the “UPS” portion of Applicant’s Mark does not remove that element from the likelihood of confusion analysis. See TMEP § 1213.10. The disclaimed matter cannot be ignored. In sum, PICL seeks to use the designation “HYBRID GREEN UPS” on electrical

¹ UPS does not agree that “UPS” is descriptive of any goods or services. However, because Applicant has disclaimed that designation for this application, this issue is irrelevant to the current proceeding.

components even though UPS has so extensively used the mark “UPS” that it has become a famous mark, and after UPS has used its famous mark “UPS” on electrical components (such as the “DIAD” device). See Opposer’s Main Brief, pp. 16-18. A consideration of these and other key du Pont factors demonstrate the existence of a likelihood of confusion. UPS replies in detail to several points raised by PICL as follows.

a. The Mark “UPS” is Famous, Not “inherently weak.”

PICL admits that the mark “UPS” is famous. PICL Brief, p.22. (“The fame of Opposer’s mark ‘UPS’...”; “Applicant admits that the mark ‘UPS’ is...well known...”). Of course, it is well established that when fame is present, “evidence pertaining to this factor “plays a ‘dominant role’ in the process of balancing the du Pont factors.” Kraft Foods Global Brands LLC v. Brown, 2009 TTAB LEXIS 569 (Trademark Trial & App. Bd. Aug. 20, 2009) (quoting Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). “Famous marks thus enjoy a wide latitude of legal protection.” Recot Inc., 54 USPQ2d at 1897.

Nonetheless, PICL ignores and seeks to avoid this fame by limiting it to transportation and shipping. Applicant’s Main Brief, p. 22. Applicant characterizes the UPS mark as inherently “weak” mark in the “power supply channel of trade” and argues that the mark is of “UPS” is of no consequence because certain persons in the “power supply channel of trade” have adopted the letters “ups” as indicative of an uninterruptible power system. Id. at 16, 18.

PICL’s arguments fail for several reasons. First, the evidence of fame is overwhelming. UPS has introduced substantial evidence that the UPS Mark is a very

strong, famous mark entitled to the broadest scope of protection. A famous mark is one "with extensive public recognition and renown." Kenner Parker Toys v. Rose Art Industries, Inc., 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). UPS was ranked the 42nd most valuable brand in the world in 2007. Schenken Dep. p. 95, Ex. 40. UPS was ranked the 38th most valuable brand in the world in 2008 and 32nd in 2009. Id. p. 96, Ex. 41. The fame or strength of a mark is determined by a variety of factors, including the length of time the mark has been in use, the volume of sales under the mark and the extent of advertising or promotion of the goods or services with which the mark is used. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983). The UPS mark has been in continuous use since 1933. Schenken Dep. p. 37. As outlined in the confidential portions of Opposer's Main Brief, UPS annually spends substantial amounts of money advertising and promoting its goods and services under the mark "UPS". Those goods and services have yielded remarkably high sales. The evidence shows what is already apparent to consumers in the United States, and really worldwide -- that UPS is a famous, well-know, and widely recognized trademark and service mark. As such, fame weighs heavily in favor of UPS in the balancing of the du Pont factors and the "UPS" mark is entitled to a broad scope of protection.

Second, fame or strength of a mark is not limited only to the products or services on which it has been used. Rather, fame can and does extend to related and unrelated goods. The Federal Circuit has stated that "fame of a mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." Recot, Inc. v. Becton, 214 F.3d 1322, 1327 (Fed. Civ.

2000). Thus, even if the many personal computers, DIADs, PDAs and other many battery activated devices used in the business of UPS were not “related” to a power supply surge protector such as that offered by PICL, that fact would be of no moment. The fame of the UPS mark is a dominant factor in the likelihood of confusion analysis independent of any relatedness of the goods. Applicant cannot admit that the mark “UPS” is famous and then dismiss it.

b. Applicant has incorrectly characterized UPS’s channels of trade and consumers.

Applicant next seeks to limit the channels of trade and consumers of UPS goods and services to “persons who are transporting various packages.” Applicant’s Brief, p. 21. Again, this is misplaced. Persons in virtually all trade channels send packages and letters. Thus, UPS’s primary or core business of small package delivery impinges on every conceivable channel of trade. Moreover, UPS’s customer base goes beyond persons who are sending or receiving packages. UPS offers many varied business services that are advertised, marketed, offered and provided to business owners, both large and small, all under the famous mark “UPS”. See, for example, Scheken Dep. pp. 20-21. UPS offers logistics services, fleet management services, credit services, insurance services, financial services - the list goes on and on. Id. at pp. 42-43, see also, www.ups.com.

Of course, the identification of goods and services in the PICL at issue are not limited in any way to certain channels of trade. Rather, they are broadly stated and would include the channels of trade in which UPS offers and provides both its core and other services.

Importantly, Applicant fails to recognize that its products are not offered only to the “power supply channel of trade.” Rather, as shown on its website, PICL seeks to offer and sell its electronic products to anyone who needs to protect an electronic component from a power surge or power outage. Thus, PICL’s actual channels of trade cover anyone who uses a computer, a PDA, a cell phone, etc. Simply put, Applicant’s claim that its goods are in different channels of trade than UPS’s goods and services is not incorrect. There is substantial overlap.

c. The commercial impression of Applicant’s Mark does not differ from the Family of UPS Marks.

Applicant’s Mark and the UPS Family of Marks do not create different commercial impressions. The reason that UPS has introduced the multitude of evidence showing its use of the UPS Mark with “green” initiatives and hybrid vehicle use is to demonstrate that Applicant’s use of “UPS” in connection with the descriptive terms “hybrid” and “green” create the same commercial impression as UPS’s numerous uses of the UPS Mark in connection with the terms “hybrid” and “green.” A simple example suffices. It is established the UPS utilizes “hybrid” delivery trucks as a part of its “green” initiative. Thus, a customer may see a “UPS Hybrid” vehicle, which would be used to deliver a package as a part of the UPS “Decision Green” program. That same customer could then see an electronic component offered under the mark “HYBRID GREEN UPS.” Given the fame of the mark “UPS”, it is likely that customer will be confused into the incorrect belief that UPS is affiliated with or in some way connected with that electronic device.

d. UPS's goods and services are not limited to "transportation and delivery."

Applicant claims that all of UPS's goods and services are specifically claimed as being directed to the delivery, tracking, transportation and invoicing of packages. Applicant's Brief, p. 19. This is not so. For example, U.S. Registration 2,973,108 is for the mark UPS and Design as used for a wide variety of computer hardware, software, and electronic goods that are not specified as related to delivery or transportation services. These goods are very similar, and at the least, related to the goods identified in the PICL application at issue.

The present case is not unlike others that have come before this Board incorporating the marks of others. For example, see In re Jewelmasters, Inc., 221 USPQ 90 (TTAB) ("Jewelmasters" for retail jewelry store service held likely to be confused with "Master Jeweler's Collection" for jewelry) and Hewlett-Packard Co. v Packard Press Inc., 281 F. 3d 1261 (Fed. Cir. 2002) ("Given the dominance of the word 'Packard' in 'Packard Technologies' and HP's heavy involvement in the technology field, this court agrees with the Board that the similarities in the marks ['Packard Technologies' and 'Hewlett Packard'] outweigh the differences. Substantial evidence supports the Board's finding that the marks are similar in their entireties"). Similarly here, the du Pont factors weigh in favor of a finding of likelihood of confusion. Registration of the Application should therefore be refused under 15 U.S.C. § 1052(d).

CONCLUSION

Opposer UPS respectfully submits that the Board should the designation “HYBRID GREEN UPS” is merely descriptive. Alternative, UPS submits that the Board should find that a likelihood of confusion exists between the designation “HYBRID GREEN UPS” and the famous mark “UPS.

Date: June 1, 2010

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing Opposer's Opposition Brief and Exhibits A-M thereto is being transmitted to the United States Patent and Trademark Office through the Electronic System for Trademark Trials and Appeals ("ESTTA") on the date indicated below:

Dated: June 1, 2010

/Elizabeth M. Fox/

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